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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,045	09/13/2003	David J. Laverick	702.276	1970
38933	7590	05/09/2006	EXAMINER	
GARMIN LTD. C/O GARMIN INTERNATIONAL, INC. ATTN: Legal - IP 1200 EAST 151ST STREET OLATHE, KS 66062			LUU, MATTHEW	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary	Application No. 10/663,045	Applicant(s) LAVERICK ET AL.	
	Examiner LUU MATTHEW	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/7/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the new added limitation in claim 27, lines 7-11, "a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left by the docking station" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new added limitation in claim 27, lines 7-11, "a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left by the docking station" was not described in the specification as originally filed.

Claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 24 is drawn to "a mounting assembly for mounting on an existing support pillar of the vehicle" as shown in Fig. 14 of the drawings. However, dependent claim 27 is drawn to "a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left by the docking station", which is not related to Fig. 14 of the drawings. Therefore, it is not clear where exactly in the specification and drawings that connect the retractable face plate as claimed (claim 27) to the mounting assembly on an existing support pillar of the vehicle (claim 24).

Dependent claim 28 is considered rejected for incorporating the defect from its respective parent claim 27 by dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempfers et al (5,415,554) in view of Anderson et al (6,827,384) and/or Gort et al (US 2003/0127878).

Regarding claim 1, Kempkers discloses (Figs. 1, 2 and 4) a navigation assembly (a compass 50 and a compass housing 28); and a mounting assembly (Fig. 4, panel 21) for mounting on a support pillar (18) of the vehicle (10) and sized and configured to receive the navigation device (compass 50) (Column 3, lines 21-42; and column 4, lines 20-24). Kempkers further discloses (Fig. 1) wherein the navigation device (50) remains visible (visible display 54) when received within the mounting assembly (panel 21).

The only different between the disclosure of Kempkers and the claimed invention is that claim 1 requires "a portable" navigational device.

However, Anderson discloses (Figs. 1-3 and 7-10) a mounting assembly (30) for mounting on a support pillar of the vehicle configured to removably receive a portable navigation device (20) (Column 3, lines 44-56; and column 7, lines 11-24, teaches the portable personal data assistants (PDA) and portable GPS receivers).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the navigation assembly of Anderson for the navigation assembly of Kempkers to provide a mounting assembly wherein different articles such as PDA, wireless phones, GPS, etc. can be easily removable attached thereon.

Gort (US 2003/0127878), on the other hand, also discloses (Fig. 1 and 2) a mounting assembly (10) for mounting a navigational device on a pillar (Section 29, the last 5 lines; and section 41, lines 1-13).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the mounting assembly (10) of Gort to receive and support the navigational device

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of Kempkers to provide a mounting assembly (10) that is capable of removably and interchangeably receiving and supporting a wide variety of navigational devices.

Regarding claim 2, Gort further teaches a wide variety of articles (GPS receivers) are designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle (Section 41, lines 1-13).

Regarding claim 3, Kempkers discloses (Fig. 1) wherein the support pillar (18) is a pillar directly above the vehicle's windshield (17).

Regarding claim 4, Anderson further discloses (Figs. 15A-15C) the mounting assembly includes a trim piece (202), a base (204), a docking station (storage place 206), and a retractable face plate (panel 208) mounted within the docking station (206). Furthermore, it is well known in the art that a CD music disc player can be considered as a face plate for inserting within the CD player docking station.

Regarding claim 5, Kempkers discloses (Figs. 3-5) electrical connections.

Regarding claim 6, Anderson further discloses a speaker in the docking station (Column 7, lines 1-2 and lines 16-18). Furthermore, it is well known in the art that the navigation device is voice activated.

Regarding claim 22, Gort further teaches a wide variety of articles (GPS receivers) are designed to be “operable” to function independently of the mounting assembly (Section 41, lines 1-13).

Furthermore, regarding the term “operable to function independently...”

The statements of intended use or field of use, “operable to”, “adapted to”, or “capable of” clause are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP 2114:

“A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2nd 1525, 1528.”

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As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Regarding claim 23, Kempkers discloses (Fig. 1) wherein the support pillar (18) is a pillar directly above the vehicle's windshield (17).

Regarding claim 24, note the rejection as set forth above with respect to claim 1. Furthermore, Anderson discloses (Figs. 1-3 and 7-10) a mounting assembly (30) for mounting on a support pillar of the vehicle configured to removably receive a portable navigation device (20) (Column 3, lines 44-56; and column 7, lines 11-24, teaches the portable personal data assistants (PDA) and portable GPS receivers).

Regarding claim 25, note the rejection as set forth above with respect to claim 2.

Regarding claim 26, note the rejection as set forth above with respect to claim 3.

Regarding claim 27, as best understood, Anderson further discloses (Figs. 15A-15C) the mounting assembly includes a trim piece (202), a base (204), a docking station (storage place 206), and a retractable face plate (panel 208) mounted within the docking station (206).

Furthermore, it is well known in the art that the car cassette player or a CD music disc player having a face plate for inserting music tape or music CD within the docking station and "operable" to retract when the music tape is received within the docking

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station and extend when the music tape is removed from the docking station, thereby covering the void left by the docking station.

Regarding claim 28, Anderson further discloses a speaker in the docking station (Column 7, lines 1-2 and lines 16-18). Furthermore, it is well known in the art that the navigation device is voice activated.

Regarding claim 29, Kempkers discloses (Figs. 3-5) electrical connections.

Claim Rejections - 35 USC § 103

Claims 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempkers in view of Anderson and/or Gort as applied to claims 1-6 above, and further in view of Ockerse et al (6,928,366).

Regarding claims 7 and 30, Kempkers fails to disclose the GPS device.

However, Ockerse discloses (Fig. 3) a GPS device includes a navigation component (GPS 118 and magnetic sensor circuit 102), a processor (110), a memory (non-volatile memory 112), a display (heading indicator 114), an input (user input 116), and it is well known in the art that these well known components are assembled in the housing. See column 9, line 40 to column 10, line 30.

Therefore, it would have been obvious to the person of ordinary skill in the art to use the GPS compass device of Ockerse for the compass device of Kempkers to provide a more accurate navigation device.

Answer to Arguments With Traverse

Applicant's arguments filed February 28, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument (Page 13) that there is no suggestion to combine the references and these references teach away from the claimed invention, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kempkers discloses (Figs. 1, 2 and 4) a navigation assembly (a compass 50 and a compass housing 28); and a mounting assembly (Fig. 4, panel 21) for mounting on a support pillar (18) of the vehicle (10) and sized and configured to receive the navigation device (compass 50) (Column 3, lines 21-42; and column 4, lines 20-24). Kempkers further discloses (Fig. 1) wherein the navigation device (50) remains visible (visible display 54) when received within the mounting assembly (panel 21).

The only different between the disclosure of Kempkers and the claimed invention is that claim 1 requires "a portable" navigational device.

However, Anderson discloses (Figs. 1-3 and 7-10) a mounting assembly (30) for mounting on a support pillar of the vehicle configured to removably receive a portable navigation device (20) (Column 3, lines 44-56; and column 7, lines 11-24, teaches the portable personal data assistants (PDA) and portable GPS receivers).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the navigation assembly of Anderson for the navigation assembly of Kempkers to provide a mounting assembly wherein different articles such as PDA, wireless phones, GPS, etc. can be easily removable attached thereon.

Gort (US 2003/0127878), on the other hand, also discloses (Fig. 1 and 2) a mounting assembly (10) for mounting a navigational device on a pillar (Section 29, the last 5 lines; and section 41, lines 1-13).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the mounting assembly (10) of Gort to receive and support the navigational device of Kempkers to provide a mounting assembly (10) that is capable of removably and

In response to applicant's argument (page 13) that Kempkers and Anderson is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

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(Fed. Cir. 1992). In this case, all of Kempkers , Anderson and Gort disclose the navigation devices (the electrical compass 50 of Kempkers, the GPS or PDA of Anderson, and the GPS of Gort) are all mounted on a mounting assembly for mounting on a support pillar of the vehicle. Therefore, these three above cited references are in the same field of endeavor.

Applicant's election with traverse of Group I in the reply filed on November 29, 2005 is acknowledged. The traversal is on the ground(s) that "However, all claims have limitations directed to a support pillar of a vehicle". This is not found persuasive because the process as claimed can be practiced by another materially different apparatus such as the DVD player being installed in different positions such as overhead console or a dashboard of a vehicle. In addition, the apparatus as claimed does not required installing the navigational device into a vehicle to work, i.e. a user can take the navigation device for hiking.

Furthermore, inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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M. Luu

A handwritten signature in black ink, appearing to read 'Matthew Luu', with a large, sweeping initial 'M'.

MATTHEW LUU
PRIMARY EXAMINER